

allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by changing colors or features, or combining the original image with portions from other digital image" column 6, line 1-6).

Applicants respectfully traverse the Section 102 rejection. Per MPEP Section 706.02, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Here, Oberg shows neither the perspective view nor the mapping element.

Oberg does not show providing a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame. The Office Action points to Figure 3's frame moulding 62 as anticipating this operation. However, the frame molding 62 shown in FIG. 3 is shown as a top view, indicating that it is NOT a perspective view but a 2D top view. Further, the superimposition operation mentioned in Oberg is consistent with the 2D top view since in a 2D view, differing layers only need to be super-imposed to provide a combined view.

Moreover, Oberg fails to show the "providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view." Here, Oberg's column 6, line 1-6 shows the image editing software and, as discussed above, Oberg does not show the perspective view. However, Oberg is absolutely devoid of the claimed specifics of an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view. Oberg is completely silent on where the editing set is placed relative to the frame image. Oberg's Fig. 3 shows only the frame and nothing else.

Hence, Oberg cannot anticipate claim 1 since it lacks all claimed elements. Since a Section 102 rejection requires EACH and EVERY element to be present, Oberg cannot anticipate claim 1's "providing a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame; mapping the picture image to the picture portion of the frame image in order to generate the frame prototype image; and providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view." Withdrawal of the Section 102 rejection on claim 1 is respectfully requested.

Applicants also traverse the rejection of claim 26 on the same two grounds, namely that Oberg does not show the perspective view and the enhanced edit set along with the frame image,

the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view.

In sum, since Oberg does not show a number of claimed elements recited in the independent claims, Applicants submit that Oberg cannot anticipate any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims. Withdrawal of the Section 102 rejection on all claims is respectfully requested.

#### The §103 Rejection

Claim 27 was rejected under Section 103(a) as unpatentable over Oberg and Morris (6,453,361). Morris relates to an online system with a server for communicating with both client devices and photo-sharing web sites over a network.

Applicants respectfully traverse the rejection of claim 27. Here, neither Oberg nor Morris shows instructions to provide a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame; map the picture image to the picture portion of the frame image in order to generate the frame prototype image; and provide an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view. Hence, claim 27 is patentable over Oberg and Morris for at least this reason.

Secondly, Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Oberg reference so as to produce the claimed invention. Further, Applicants fail to identify any motivation to modify the reference teaching so as provide uploading of images that were edited and/or previewed in the perspective view arrangements as presently claimed. Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Morris, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 27. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in either Oberg or Morris reference, or knowledge of those skilled in the art, to provide a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame; map the picture image to the picture portion of the frame image in order to generate the frame prototype image; and provide an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view, and to upload the resulting image to a server, *prima facie* obviousness of claim 27 has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claim 27 be withdrawn and the claims be allowed.

#### CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested.

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If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,



Bao Tran

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